

### REMARKS

The present application relates to soybean variety 92B84. Claims 1-49 are currently pending in the present application. Claims 1, 7, 18, 23, 29, 35, 43, 45, 46 and 48 have been amended. Applicants respectfully request consideration of the following remarks and claims as amended.

#### Detailed Action

Applicants acknowledge the objections of claims 13, 14, 35 and 36 are withdrawn. Applicants further acknowledge the rejections of claims 5, 9, 10, 13, 14, 20-23, 27, 31, 32, 39, 40, 44, 45, and 49, and claims dependent thereon, under 35 U.S.C. § 112, second paragraph are withdrawn.

#### *Claim Objections*

The Examiner acknowledges Applicants' statement regarding the deposit of biological material on page 3 of the Remarks filed May 20, 2002. The Examiner maintains the objection to claims 1, 7, 29 and 46 for the inclusion of a blank line where the ATCC accession number should be included. Applicants herein are submitting amendments to claims 1, 7, 29 and 46 and to the Specification on pages 6 and 36 to include the proper ATCC accession numbers. Applicants submit that at least 2,500 seeds of Soybean Variety 92B84 have been deposited with the ATCC on June 26, 2002. In view of these deposits, the rejections under 35 U.S.C. § 112, first paragraph should be removed (MPEP § 2411.02). Such action is respectfully requested.

#### *New Claims*

Applicants acknowledges the addition of new claims 50 through 58. The new claims do not add new matter as there is literal support for the claims in the originally filed specification (pages 12-35, specification).

#### Rejections Under 37 C.F.R. § 1.130(b)-Double Patenting

The Examiner rejects claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21, 22, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, and 47-49 under the "judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,153,816." The Examiner states, "[a]lthough the conflicting claims are not identical,

they are not patentably distinct from each other because they both appear to be drawn to the same soybean seed, plants, and plant parts. The designation "92B84" of the instantly claimed soybean variety is arbitrarily assigned, and does not provide any patentable distinction from the soybean variety claimed in '816, variety 93B35. Any differences between 92B84 and 93B35 are due to minor morphological variations that do not confer patentable distinction. Inserting the ATCC Accession No. into the instant claims will overcome the rejection." Further, the Examiner states that Applicants previous arguments in May 20, 2002 were found persuasive for claims 1-9, 11, 13, 14, 24-31, 33, 35, 36, and 46.

Applicants respectfully traverse this rejection. Claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21, 22, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, and 47-49 are patentably distinct because they involve a novel soybean seed, plants, plant parts, and methods. Applicants' detailed arguments are set forth infra in the Issues under 102/103 section. Applicants further assert the use of the designation "92B84" is not arbitrarily assigned. It is common practice within plant breeding that a new and distinct soybean seed is designated with a numerical number such as 92B84 which defines the claimed soybean seed and which has now been deposited under the proper ATCC accession number. The use of such a designation is a common practice within the art and would be well understood by one skilled in the art to be two distinct and unrelated soybean seeds. In addition, as provided in 37 C.F.R. §§ 1.801-1.809, Applicants have now amended the claims and the specification accordingly to include the ATCC accession number from the deposit of Soybean Variety 92B84, thereby making this rejection moot.

In light of the above remarks, Applicants respectfully request the Examiner withdraw the rejection to claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21, 22, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, and 47-49 under 37 CFR § 1.130(b).

#### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejects claims 1-8, 9 (amended), 10-12, 13-14 (both amended), 15-17, 18 (amended), 19, 20 (amended), 21-30, 31 (amended), 32-34, 35-36 (both amended), 37, 38, 39 (amended), 40-42, 43 (amended) and 44-49 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicants regard as the invention. The Examiner states "Amending claims 1, 7, 29 and 46 to recite the ATCC deposit number in which seed of soybean variety 92B84 has been deposited would overcome the rejection."

Applicants herein are submitting amendments to claims 1, 7, 29 and 46 and to the Specification on pages 6 and 36 to include the proper ATCC accession numbers. Applicants submit that at least 2,500 seeds of Soybean Variety 92B84 have been deposited with the ATCC on June 26, 2002. In view of these deposits, the rejections under 35 U.S.C. § 112, second paragraph should be removed (MPEP § 2411.02). Such action is respectfully requested.

The Examiner rejects claims 18 and 43 under 35 U.S.C. §112, second paragraph for improper antecedent basis. Applicants have now amended claims 18 and 43 to read --seed of the soybean plant of--, thereby obviating this rejection. Applicants thank the Examiner for pointing out this inadvertent error.

The Examiner rejects claim 35 for improper antecedent basis. Applicants have now amended the claim to read -- for developing --, as suggested by the Examiner, thereby alleviating this rejection.

The Examiner rejects claim 48 for the recitation "growing said progeny soybean seed of step (a)". The Examiner states it is not clear if the recitation is referring to step (a) of claim 48 or parent claim 46. The Examiner also states that it is not clear if the reference of steps (a) and (b) in step (c) of claim 48 refers to those steps of claim 48 or 46. Applicants have now amended claim 48 to read recite steps (c) - (e), as suggested by the Examiner, thereby alleviating this rejection.

The Examiner rejects claims 23 and 45 for the recitation of terms such as "relative", "very good", "moderate", "above average", "substantial degree" and "particularly suited" and for the recitation of "North Plains, Plains, Southern Plains, and Eastern regions of the United States" as these terms are indefinite and do not reasonably apprise one of the scope of the invention.

Applicants respectfully traverse this rejection. Each of these claims recites two requirements, first that 92B84 be an ancestor of the plant and second, that the claimed plant be "capable of expressing a combination of at least two 92B84 traits" selected from a Markush grouping. Applicants note that the Markush listing is directed to "92B84" traits. Thus, Applicants submit that the recitation of 92B84 traits clearly delineates the traits listed as those

which are from 92B84 or ancestors thereof. The recitation of "92B84" in front of the term traits clearly indicates that the traits must be originating from 92B84. This is particularly so since the claim also requires that the plant 92B84 must be an ancestor of the claimed plant. Applicants further submit that the adjectives used within the claims are not unduly narrative or imprecise as they do clearly characterize and positively recite the degree of expression of the particular traits within the application in Tables 1-2 (pages 11 and 28-35). This terminology is well known in the art and commonly used within breeding techniques of soybean plants. In addition, Applicants have amended claims 23 and 45 by adding the threshold, having 50% of the alleles, as well as an assayable function, capable of expressing at least a combination of two traits of 92B84. There is literal support for the amended claims found in the specification on page 3 and beginning on page 10 of the instant specification. Further, Applicants have now deleted the areas of adaptability therefore alleviating the rejection to the recitation of regions. Applicants therefore respectfully submit that this language is not indefinite and would be understood by one in the art and is the terminology of use within the art. Therefore, Applicants respectfully request reconsideration.

Furthermore, in Georgia-Pacific, the Federal Circuit stated that "...the policy of the patent statute contemplates granting protection to valid inventions, and this policy will be defeated if protection were to be accorded to those patents which were capable of precise definition." Georgia-Pacific Corp. v. U.S. Plywood Corp., 258 F.2d 124, 136, 118 U.S.P.Q. 122 (2nd Cir.). While some decisions have advocated the general statement that "[a]n invention must be capable of accurate definition, and it must be accurately defined, to be patentable, (See United Carbon Co. v. Binney & Smith Co., 1942, 317 U.S. 228, 237, 63 S.Ct. 165, 170, 87 L.Ed. 232), the Federal Court has stated that "such general statements, however, must be viewed in the context of circumstances. Objectionable indefiniteness must be determined by the facts in each case, not by reference to an abstract rule." Georgia-Pacific at 136. "Patentable inventions cannot always be described in terms of exact measurements, symbols and formulae, and Applicants necessarily must use the meager tools provided by language, tools which admittedly lack exactitude and precision. If the claims read in light of the specification, reasonably apprise those skills in the art both in utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." Id. (See North American Vaccine Inc. v.

American Cyanamide Co., 7 F.3d 1571, 28 U.S.P.Q.2d 1333, 1339 (Fed. Cir. 1993)). Moreover, it is against the policy of the patent statute to bar patent protection for inventions that are incapable of precise definition. Georgia-Pacific at 136. With respect to the above-mentioned terms, the claims are as precise as the subject matter of the invention permits. Therefore, Applicants respectfully request reconsideration of the claims.

In light of the above remarks, Applicants submit that claims 1-8, 9 (amended), 10-12, 13-14 (both amended), 15-17, 18 (amended), 19, 20 (amended), 21-30, 31 (amended), 32-34, 35-36 (both amended), 37, 38, 39 (amended), 40-42, 43 (amended) and 44-49 clearly define and distinctly claim the subject matter Applicants regard as the invention. Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

The Examiner maintains the rejection to claims 10, 21-23, 32, 40, 44, 45 and 49 and rejects claims 12, 15-17, 18 (amended), 19, 20 (amended), 34, 37, 38, 39 (amended), 41, 42, 43 (amended), 47, and 48 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey that the inventor had possession of the invention. The Examiner indicates that the claim of any tissue culture of cells, any soybean plant from breeding, or any plant derived therefrom with two traits which all originating from soybean plant 92B84 is not described in the specification and the characteristics of the progeny are nowhere disclosed. Applicants respectfully traverse. There is great detail in the specification as to culture techniques and breeding techniques and how one applies these techniques to soybean plant 92B84 to generate the derived plants or tissue cultures of the invention. Claims 23 and 45, as amended, even claim that the plant has derived at least 50% of its alleles from 92B84 and must possess at least two of several enumerated traits that must be from plant 92B84. Each claimed plant that is created using Applicants unique and novel material will possess the unique germplasm that forms the invention. Applicants have described plants of the invention as well as making a deposit of the same. It is submitted that this in combination with the detailed information about breeding satisfies the requirements of § 112.

The Examiner states that claims 1-8, 9 (amended), 10-12, 13-14 (both amended), 15-17,

18 (amended), 19, 20 (amended), 21-30, 31 (amended), 32-34, 35-36 (both amended), 37, 38, 39 (amended), 40-42, 43 (amended), and 44-49 remain rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons of record stated in the Office action mailed December 18, 2001. The Examiner states Applicants' arguments in the paper received May 20, 2002 were fully considered but were not found persuasive.

Applicants respectfully submit herein are amendments to claims 1, 7, 29 and 46 and to the Specification on pages 6 and 36 to include the proper ATCC accession numbers. Applicants submit that at least 2,500 seeds of Soybean Variety 92B84 have been deposited with the ATCC on June 26, 2002. Further, Applicants assert the written description requirement set forth in 35 U.S.C. § 112 is met, particularly in light of the fact that, as stated above, Applicants have reduced the invention to practice and deposited the derived biological materials in a public depository, thereby demonstrating its "possession" of the invention. Enzo Biochem Inc., v. Gen-Probe, Inc., 63 U.S.P.Q.2d (BNA) 1609, 1613 (Fed. Cir. 2002) ("In light of the history of biological deposits for patent purposes, the goals of the patent law, and the practical difficulties of describing unique biological materials in a written description, we hold that reference in the specification to a deposit in a public depository, which makes its contents accessible to the public when it is not otherwise available in written form, constitutes an adequate description of the deposited material sufficient to comply with the written description requirement of § 112, 1."); see also MPEP § 2163.02 (8th ed. Aug. 2001) ("Under Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 U.S.P.Q.2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.") In view of these deposits, the rejections under 35 U.S.C. § 112, first paragraph should be removed (MPEP § 2411.02). Such action is respectfully requested.

#### **Issues Under 35 U.S.C. §§ 102/103**

The Examiner rejects claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21-23, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, 45, and 47-49 under 35 U.S.C. § 102(e) as

anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as obvious over Steiger et al. (U.S. Patent No. 6,153,816). The Examiner also states that amending claims to include ATCC accession number will overcome the rejection for claims 1-9, 11-20, 24-26, 28-31, 33-39, 41-43 and 46-48. Applicants have submitted herein amendments to claims 1, 7, 29 and 46 and to the Specification on pages 6 and 36 to include the proper ATCC accession numbers. Applicants submit that at least 2,500 seeds of Soybean Variety 92B84 have been deposited with the ATCC on June 26, 2002. In view of these deposits, the rejections under 35 U.S.C. § 102(e), should be removed.

The Examiner goes on to state that "even with the inclusion of ATCC number, the plants of claims 10, 21-23, 32, 40, 44, 45 and 49 are still taught by Steiger et al., as variety 93B35 has at least two characteristics of 92B84 listed in those claims. The process of making the claimed plants does not distinguish the plants themselves from those taught by the reference. Thus, the claimed invention was clearly *prima facie* obvious as a whole to one of ordinary skill in the art, if not anticipated by Steiger et al."

Applicants respectfully traverse this rejection. Once again, the Applicants would like to point out that the inventions 92B84 and 93B35 are not the same inventions. Nor are their differences "minor morphological variations". Applicants submit that though 93B35 and 92B84 exhibit some similar traits, what is being claimed is not the trait but the unique combination of alleles contained in 92B84. Applicants submit that the claimed plant cannot be rendered obvious or lacking novelty as it possesses a unique combination of traits which confers a unique combination of genetics. Moreover, pursuant to the recent Federal Circuit decision, Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education & Research, No. 00-1467 (Fed. Cir. Aug. 30, 2002), "a novel patented product is not "anticipated" if it did not previously exist." Id. This is the case whether or not the process for making the new product is generally known. Id. The invention 92B84 has not previously existed as it is the result of crossing soybean variety 92B84 with itself or another soybean plant, and the creation of variants by mutagenesis or transformation of soybean 92B84.

As will be shown herein Soybean Variety 92B84 is clearly differentiated from Soybean Variety 93B35. Further, hybrids or other plants derived from 92B84 are also clearly differentiated. It must be recognized that the hybrids provided by this soybean variety are

themselves unusual and an un-obvious result of a combination of previously unknown and non-obvious genetics through common process. In addition to the phenotypic traits described herein, each soybean has additional benefits unique to each specific cross using 92B84 as one of the parents. Thus, they deserve to be considered as new and non-obvious compositions in their own right as products of the process of hybridization when 92B84 is used as a starting material.

When looking at soybean plants it would be possible to find many traits that are similar between varieties such as the color of the flowers or growth habit. However, to say that there are similarities in phenotype between two varieties is not the same as saying that the two varieties had the same morphological and physiological characteristics as a whole, or that one is an obvious variant of the other. Further, similarity in phenotype does not mean that the two varieties will perform similarly, particularly in a breeding program. In the instant application, the Examiner has noted some similarities in the morphologies of soybean variety 92B84 and the soybean variety 93B35. However, in addition to these similarities, there are also notable differences. As will be demonstrated below, several morphological and physiological characteristics of soybean 92B84 are either different from or not present in 93B35.

When looking at the tables of both inventions, varieties created using 92B84 as one of the parents are clearly not anticipated by varieties made using 93B35 as one of the parents. For example, 92B84 has more susceptibility to stalk lodging when compared to 93B35. As reported in Tables 2A through 2H in the specification 92B84 demonstrates a superior resistance average score of 7.42. As reported in Tables 2A-2K of the '816 patent, 93B35 demonstrates a much better tolerance, with an average score of 8.4. This is a substantial difference. Another example of the differences is that 92B84 exhibits superior resistance to Brown Stem Rot than 93B35. As reported in the same tables, 92B84 demonstrates superior tolerance with an average score of 9 while 93B35 demonstrates an average score of 8. Yet another example is maturity, 92B84 has a relative maturity of 28 while 93B35 has a relative maturity of 33. This is a large difference in maturity and will affect area of adaptation.

Other traits which differ between the two inventions include: flower color, (92B84 white, 93B35 purple), average yield (92B84 53.1 bushels per acre, 93B35 52.4 bushels per acre), and Sudden Death Syndrome tolerance, (92B84 has moderate tolerance while 93B35 is susceptible).

The examples and the list are not exhaustive but they give ample evidence that the



inventions are not the same. Nor are they minor variations of each other. Applicants acknowledge that insertion of the ATCC Accession Number will overcome this rejection. Applicants respectfully submit that the pertinent claims have now been amended to include the proper ATCC accession number from deposit that has been made as set forth in 37 CFR §§ 1.801-1.809.

Further, In re Thorpe, states that "a product by process claim may be properly rejected over prior art teaching the same product produced by a different process", as noted by the Examiner. 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985). However, Applicants submits that this is not the same product physiologically or morphologically as the cited prior art as can be evidenced by one skilled in the art through analysis of the data tables in each. In addition, it is impermissible to use hindsight reconstruction and the benefit of Applicant's disclosure to pick among pieces which are present in the art, there must be some suggestion to make the combination and an expectation of success. In re Vacck, 20 U.S.P.Q.2d 1434 (Fed. Cir. 1991). Further, any phenotypic trait that is expressed is the result of the genetic material present in the plant, and 92B84 will have its own unique genetic background that will give rise to the claimed plant and this profile along with its combination with other plants will result in a unique combined genetic profile that is the product claimed. Thus, the present application deserves to be considered new and non-obvious compositions in their own right as products of crossing when 92B84 is used as a starting material.

In light of the above, Applicants respectfully requests the Examiner reconsider and withdraw the rejection to claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21-23, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, 45, and 47-49 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Steiger et al. (U.S. Patent No. 6,153,816).

#### **Issues Under 35 U.S.C. § 103**

The Examiner rejects claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21-23, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, 45, and 47-49 under 35 U.S.C. § 103 (a) as obvious over Steiger et al. (U.S. Patent No. 6,153,816). The Examiner states the "any plant expressing at least two of the listed traits will render obvious the claimed invention".

Applicants respectfully traverse this rejection. When looking at a soybean plant it would be possible to find many traits that are similar between varieties such as the color of flowers or growth habit. However, to say there are similarities in phenotype between two varieties is not the same as saying that the two varieties have the same morphological and physiological characteristics as a whole, or that one is an obvious variant of the other. Further, similarity in phenotype does not mean that the two varieties will perform similarly, particularly in a breeding program. It is important to note that variety with respect to agricultural variety may be defined as a group of similar plants that by structural features and performance can be identified from other varieties within the same species.

Applicants submit that Variety 93B35 does not exhibit the same characteristics as 92B84. Applicants will illustrate how 92B84 and 93B35 are different. Steiger '816 does not teach or suggest soybean variety 92B84 developed by a soybean breeding program or the use of soybean plant 92B84 in the production of tissue culture. It must be recognized that the varieties provided by this invention are themselves unusual and un-obvious results of a common process, in that they provide the unique combination of a relative maturity of 28, very good yield in combination with a Multi-race *Phytophthora* resistance, very good resistance to Brown Stem Rot, moderate tolerance to Sudden Death Syndrome, above average iron deficiency tolerance, and does well in *Phytophthora megasperma* infected soils where the *Rps1k* gene provides resistance (see pages 10-11, specification). Nonetheless, soybean 92B84 deserves to be considered as a new and non-obvious composition in its own right as does its tissue culture as products of the process when 92B84 is used as starting material. Applicants point out that 92B84 is a unique plant soybean which never before existed until Applicants filed the application and until its deposit of the same. While Steiger '816 does teach the general regeneration of soybean plants from tissue culture techniques, it does not teach or suggest the use of the unique soybean variety 92B84. As will be demonstrated below, several morphological and physiological characteristics of soybean 92B84 are either different from or not present in 93B35.

For example, 92B84 has more tolerance to Brown Stem Rot when compared to 93B35. The varieties are also different with respect to flower color, stalk lodging, relative maturity, and bushels per acre. Differences between the two varieties are summarized in the table below:

<u>CHARACTERISTICS</u>	<u>92B84</u>	<u>93B35</u>
Flower color	White	Purple
Stalk Lodging	7.42	8.4
Brown Stem Rot Tolerance	Superior Tolerance	Moderate Tolerance
Relative Maturity	28	33
Average Yield (bushels per acre)	53.1	52.4

This comparison clearly shows that soybean variety 93B35 does not exhibit the characteristics of soybean variety 92B84. Further, the present application clearly shows in Table 1 at p. 11 and Tables 2A-2H that soybean variety 92B84 exhibits above average tolerance to Sudden Death Syndrome tolerance, iron deficiency chlorosis tolerance, black hila, and a very good yield in combination with Multi-race Phytophthora resistance.

In light of the above, Applicants respectfully requests the Examiner reconsider and withdraw the rejection to claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21-23, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, 45, and 47-49 under 35 U.S.C. § 103(a).

### Conclusion

Applicants submit that, in light of the foregoing amendments and remarks, the claims, as amended and as newly presented herein, are in condition for allowance. Reconsideration and early notice of allowability are respectfully requested.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

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Application No. 09/747,589

**AMENDMENT — VERSION WITH MARKINGS  
TO SHOW CHANGES MADE**

**In the Specification**

Please replace the paragraph at page 6, following "SUMMARY OF THE INVENTION", beginning at line 2 with the following:

According to the invention, there is provided a novel soybean variety, designated 92B84. This invention thus relates to the seeds of soybean variety 92B84, deposited with the American Type Culture Collection, with an ATCC Deposit No. of PTA-4500, to the plants of soybean 92B84 and to methods for producing a soybean plant produced by crossing soybean variety 92B84 with itself or another soybean plant, and the creation of variants by mutagenesis or transformation of soybean 92B84. This invention also relates to methods for producing other soybean varieties or breeding lines derived from soybean variety 92B84 and to soybean varieties or breeding lines produced by those methods. Variety 92B84 exhibits a unique combination of yield potential and disease resistance that make it an important variety for its area of adaptation.

Please replace the paragraph beginning at page 36 line 2 with the following:

[A deposit of the seed of soybean variety 92B84 is and has been] Applicant has made a deposit of at least 2500 seeds of soybean variety 92B84 with the American Type Culture Collection (ATCC), Manassas, Va. 20110 USA. ATCC Deposit No. PTA-4500. The seeds deposited with the ATCC on June 26, 2002 were taken from the deposit maintained by Pioneer Hi-Bred International, Inc., 800 Capital Square, 400 Locust Street, Des Moines, Iowa 50309-2340, since prior to the filing date of this application. Access to this deposit will be available during the pendency of the application to the Commissioner of Patents and Trademarks and persons determined by the Commissioner to be entitled thereto upon request. Upon allowance of any claims in the application, the Applicant(s) will make the deposit available to the public

pursuant to § 1.808 [without restriction a deposit of at least 2500 seeds of variety 92B84 with the American Type Culture Collection (ATCC), 10801 University Boulevard, Manassas, VA 20110-2209. The seeds deposited with the ATCC will be taken from the same deposit maintained at Pioneer Hi-Bred and described above]. Additionally, Applicant(s) will meet all the requirements of 37 C.F.R. §§ 1.801 - 1.809, including providing an indication of the viability of the sample when the deposit is made. This deposit of Soybean variety 92B84 will be maintained in the ATCC Depository, which is a public depository, for a period of 30 years, or 5 years after the most recent request, or for the enforceable life of the patent, whichever is longer, and will be replaced if it ever becomes nonviable during that period. [Applicant will impose no restrictions on the availability of the deposited material from the ATCC; however,] Applicant has no authority to waive any restrictions imposed by law on the transfer of biological material or its transportation in commerce. Applicant does not waive any infringement of its rights granted under this patent or under the Plant Variety Protection Act (7 USC 2321 et seq.) which may protect Soybean variety 92B84.

#### **In the Claims**

Please amend claims 1, 7, 18, 23, 29, 35, 43, 45, 46 and 48 as follows:

1. (Amended)

A soybean seed designated 92B84, representative seed of said soybean variety 92B84 having been deposited under ATCC Accession No. [ ] PTA-4500.

7. (Amended)

A soybean plant regenerated from the tissue culture of claim 5, capable of expressing all the morphological and physiological characteristics of soybean variety 92B84, representative seed of said soybean variety 92B84 having been deposited under ATCC Accession No. [ ] PTA-4500.

18. (Twice Amended)

An F<sub>1</sub> hybrid soybean plant, or parts thereof, grown from the seed of the soybean plant of claim 17.

## 23. (Amended)

The soybean plant of claim 22 wherein said soybean plant or parts thereof, has derived at least 50% of its alleles from 92B84 and is capable of expressing [express] a combination of at least two 92B84 traits selected from the group consisting of: a relative maturity of 28, very good yield, Multi-race Phytophthora resistance [(Rps1k)], resistance to Brown Stem Rot, moderate Sudden Death Syndrome tolerance, above average iron deficiency chlorosis tolerance, and a substantial degree of glyphosate resistance[, and particularly suited to the North Plains, Plains, Southern Plains and Eastern regions of the United States including Iowa, Illinois, Indiana, Missouri, Michigan, Wisconsin and Ohio].

## 29. (Amended)

A soybean plant regenerated from the tissue culture of claim 24, capable of expressing all the morphological and physiological characteristics of soybean variety 92B84, representative seed of said soybean variety 92B84 having been deposited under ATCC Accession No. [\_\_\_\_] PTA-4500.

## 35. (Twice Amended)

The method of claim [31] 33 for [producing] developing a first generation hybrid soybean seed wherein a soybean plant having all the morphological and physiological characteristics of soybean plant 92B84 is the female parent.

## 43. (Twice Amended)

An F<sub>1</sub> hybrid soybean plant, or parts thereof, grown from the seed of the soybean plant of claim 42.

## 45. (Amended)

The soybean plant of claim 44 wherein said soybean plant or parts thereof, has derived at least 50% of its alleles from 92B84 and is capable of expressing [express] a combination of at least two 92B84 traits selected from the group consisting of: a relative maturity of 28, very good

yield, Multi-race Phytophthora resistance [(Rps1k)], resistance to Brown Stem Rot, moderate Sudden Death Syndrome tolerance, above average iron deficiency chlorosis tolerance, and a substantial degree of glyphosate resistance[, and particularly suited to the North Plains, Plains, Southern Plains and Eastern regions of the United States including Iowa, Illinois, Indiana, Missouri, Michigan, Wisconsin and Ohio].

46. (Amended)

A method for producing a soybean variety 92B84-derived soybean plant, comprising:

- (a) crossing soybean variety 92B84, representative seed of said soybean variety 92B84 having been deposited under ATCC Accession No. [ ] PTA-4500 with a second soybean plant to yield progeny soybean seed; and
- (b) growing said progeny soybean seed, under plant growth conditions, to yield said soybean variety 92B84-derived soybean plant.

48. (Amended)

The method of claim 46, further comprising:

- [(a)][c] crossing said soybean variety 92B84-derived soybean plant with itself or another soybean plant to yield additional soybean variety 92B84-derived progeny soybean seed;
- [(b)][d] growing said progeny soybean seed of step (a) under plant growth conditions, to yield additional soybean variety 92B84-derived soybean plants; and
- [(c)][e] repeating the crossing and growing steps of (a) and (b) from 0 to 7 times to generate further soybean variety 92B84-derived soybean plants.

Please add new claims 50-58 as follows:

50. (New)

A 92B84 progeny soybean plant, or parts thereof, wherein at least one ancestor of said 92B84 progeny soybean plant is the soybean plant of claim 2, and wherein the pedigree of said soybean progeny soybean plant has 2 or less cross-pollinations to a plant other than 92B84 or a plant that has 92B84 as a progenitor.



## 51. (New)

A method for developing a 92B84 progeny soybean plant in a soybean plant breeding program comprising:

- obtaining the soybean plant, or its parts, of claim 2;
- utilizing said plant or plant parts as a source of breeding material;
- and selecting a 92B84 progeny plant with morphological and/or physiological characteristics selected from the characteristics listed in Tables 1 or 2.

## 52. (New)

The 92B84 progeny soybean plant produced by the method of claim 51.

## 53. (New)

A method for producing a population of 92B84 progeny soybean plant comprising:

- (a) obtaining a first generation progeny soybean seed comprising the plant of claim 2 as a parent;
- (b) growing said first generation progeny soybean seed to produce a population of F1 generation soybean plants; and obtaining self or sib pollinated seed from said F1 generation soybean plants; and
- (c) producing successive filial generations to obtain a population of 92B84 progeny soybean plants.

## 54. (New)

A soybean plant produced by the method of claim 53.

## 55. (New)

The population of 92B84 progeny soybean plants produced by the method of claim 53, said population, on average, deriving 50% of its alleles from 92B84.

## 56. (New)

A soybean variety selected from the population of 92B84 progeny soybean plants produced by the method of claim 53, said soybean variety deriving at least about 50% of its alleles from 92B84.

## 57. (New)

The method of claim 53, further comprising  
applying double haploid methods to said F1 generation soybean plant or to a successive filial generation thereof.

## 58. (New)

A soybean plant, or parts thereof, having all the physiological and morphological characteristics of soybean variety 92B84, representative seed of said variety having been deposited under ATCC Accession No. PTA-4500.